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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,412	02/13/2001	Gary P. Mousseau	1400-1072 D5	3123

54120 7590 04/10/2007 RESEARCH IN MOTION, LTD 102 DECKER CT. SUITE 180 IRVING, TX 75062	**EXAMINER** REILLY, SEAN M

ART UNIT	PAPER NUMBER
2153	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/10/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _16 January 2007_.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _65-118_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _65-118_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

This Office action is in response to Applicant's amendment and request for reconsideration filed on January 16, 2007. Claims 65-118 are presented for further examination. None of the claims have been amended.

Response to Arguments

Applicant contends that Eggleston unconditionally forwards attachments that pass an attachment size or type filter and thus Eggleston does not provide a command for the user to request an attachment (see Applicant response January 16, 2007, pg 26). Examiner respectfully disagrees. Foremost Examiner notes that Applicant does not claim and moreover does not have 112 1st support for *a command that explicitly requests an attachment*. Instead Applicant has merely claimed sending a command requesting more data, which may in turn result in the transmission of an attachment in the next burst of data. This functionality is identical to Eggleston. Examiner does agree with Applicant that in one embodiment of Eggleston attachments will be filtered based on size and type. However, Eggleston explicitly allows the user to override such filters and in doing so the user is able to transfer part or all of the contents within a message (see inter alia, Col 3, lines 29-34 and Col 10, line 57 – Col 11, line 4, "The user is thus able to review the summary information and make a determination on whether or not to **override the filter rejection**." (emphasis added)). Thus, Examiner maintains that Eggleston clearly disclosed Applicant's claimed *first command* in view of at least Eggleston's filter override functionality.

Claim Objections

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the

original numbering of the claims to be preserved throughout the prosecution. When claims are

canceled, the remaining claims must not be renumbered. When new claims are presented, they

must be numbered consecutively beginning with the number next following the highest

numbered claims previously presented (whether entered or not).

The number 91 references two claims. Appropriate correction is required. For the

instant office action the claims have been renumbered 91a and 91b, where 91a references the

first instance of claim 91 and 91b references the second instance of claim 91.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1.   **Claims 65, 67-70, 89, 91a, 97, 99, 108, and 110 are rejected under 35 U.S.C. 102(e) as**

being anticipated by Eggleston et al. (U.S. Patent Number 5,958,006; hereinafter

Eggleston).

With regard to claims 65, 89, 97, and 108, Eggleston disclosed a method of redirecting e-

mail messages and message attachments to a user of a mobile data communication device that is

associated with a host system and communicates therewith via a wireless gateway, the method comprising the steps of:

Receiving a data item (email) at the host system (server 115) from a message sender, the data item being directed to an address associated with the user at the host system (address of mobile user 105), the data item including an e-mail message and a message attachment (e.g. email message with attachment, Col 8, lines 30-37);

Redirecting at least a portion of the e-mail message from the host system to the mobile data communication device via the wireless gateway using a network address of the mobile data communication device (e.g. when the user has implemented a filter and only part of the message is sent to the user, seen inter alia Col 3, lines 23-26 and Col 10, lines 10-32);

Receiving a first command message from the mobile data communication device at the host system requesting more of the data item (i.e. sends the request after receiving partial or summary data for more of the message or all of the message, see inter alia Col 3, lines 29-34 or Col 10, line 57 – Col 11, line 4);

Redirecting the message attachment from the host system to the mobile data communication device via the wireless gateway using the network address of the mobile data communication device in response to first command message (i.e. when the user requests all of the message or full transfer of the message, the attachment will also be sent to the user's mobile device, again see inter alia Col 3, lines 29-34 or Col 10, line 57 – Col 11, line 4);

With regard to claims 67, Eggleston disclosed:

Configuring one or more redirection events at the host system (e.g. user sets up a filter,

see inter alia Col 8, lines 14-55);

detecting that a redirection event has occurred at the host system (i.e. an email passes the

filter criteria) and generating a redirection trigger (required internally in the system such that the

system invokes the process or procedure to actually forward the message); and

In response to the redirection trigger, redirecting at east a portion of the e-mail message

from the host system to the mobile data communication device (i.e. forwarding the message

when it passes the filter criteria).

With regard to claims 68 and 69, Eggleston disclosed the external redirection event is a

message from the mobile data communication device to start the redirection step (i.e. user

enables the filers from the mobile device, Col 9, lines 32-43). Eggleston also disclosed the

internal event includes a calendar alarm (calendar activates a filter profile, Col 9, lines 42-43).

With regard to claims 70, 91a, 99, and 110 Eggleston disclosed the mobile data

communication device is one of a hand-held wireless paging computer, a wirelessly-enabled

palm-top computer, a mobile telephone with data message capabilities and a wirelessly-enabled

laptop computer (Col 4, lines 11-13).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

2.   Claims 66, 71-88, 90, 91b, 92-96, 98, 100-107, 109, and 111-118 are rejected under 35

U.S.C. 103(a) as being unpatentable over by Eggleston et al. (U.S. Patent Number

5,958,006; hereinafter Eggleston) and Kikinis (U.S. Patent Number 5,964,833).

With regard to claims 74, 79, 103, and 114, Eggleston disclosed a method of redirecting

e-mail messages and message attachments to a user of a mobile data communication device that

is associated with a host system and communicates therewith via a wireless gateway, the method

comprising the steps of:

Receiving a data item (email) at the host system (server 115) from a message sender, the

data item being directed to an address associated with the user at the host system (address of

mobile user 105), the data item including an e-mail message and a message attachment (e.g.

email message with attachment, Col 8, lines 30-37);

Redirecting at least a portion of the e-mail message from the host system to the mobile

data communication device via the wireless gateway using a network address of the mobile data

communication device (e.g. when the user has implemented a filter and only part of the message

is sent to the user, seen inter alia Col 3, lines 23-26 and Col 10, lines 10-32);

Receiving a first command message from the mobile data communication device at the

host system requesting more of the data item (i.e. sends the request after receiving partial or

summary data for more of the message or all of the message, see inter alia Col 3, lines 29-34 or

Col 10, line 57 – Col 11, line 4);

Redirecting the message attachment from the host system to the mobile data

communication device via the wireless gateway using the network address of the mobile data

communication device in response to first command message (i.e. when the user requests all of

the message or full transfer of the message, the attachment will also be sent to the user's mobile

device, again see inter alia Col 3, lines 29-34 or Col 10, line 57 – Col 11, line 4);

Eggleston disclosed substantial features of the claimed invention including providing

typical email functions to mobile users (e.g. compose, reply, and forward). However, Eggleston

failed to specifically recite receiving a second command message from the mobile data

communication device at the host system to send the message attachment to an external device

and redirecting the message attachment from the host system to the external device in response

to the second command message. Nonetheless such functionality would occur when a user

forwarded an email message containing an email attachment to another mobile user, as would

typically occur during email use. The claimed second command is equated with the user's

forward command (i.e. user decides forward an email with an attachment) that is sent to the

server and the claimed external device is equated the intended mobile recipient of the forwarded

message including the attachment. The user would typically perform such a forwarding function

in order to convey pertinent information contained in an email or email attachment to another

mobile user.

Thus, it would have been obvious to a user of ordinary skill in the art at the time of

Applicant's invention to utilize the traditional email forwarding command in Eggleston's system

to forward an email containing an attachment to another mobile user, in order to convey information to other users.   Again such a traditional email forward command would naturally result in receiving a second command message from the mobile data communication device at the host system to send the message attachment to an external device and redirecting the message attachment from the host system to the external device in response to the second command message.

Furthermore it was widely known in the art at the time of Applicant's invention to forward email attachments to external devices other than e-mail recipient devices, as evidenced by at least Kikinis. In a similar messaging system Kikinis disclosed a system that allows users to forward email attachments to various preprogrammed external devices such as a fax machine (Kikinis Col 4, lines 50-56). By allowing users to forward attachments using other devices rather than just email, Kikinis allows users to communicate easier and with more people. For instance an external device such a fax machine may be more convenient for some users or the only form of communication available to other users who are unable to receive email at a particular location. Thus, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Eggleston's system to allow users to forward attachments to other preprogrammed external devices, as disclosed by Kikinis, so that users can communicate with other people by using different means rather than just email and thus communicate with more people.

With regard to claim 66, Kikinis disclosed providing a user profile for the mobile data communication device, wherein the user profile stores a list of one or more external device

associated with the mobile data communication device (i.e. preprogrammed external devices

such as a fax machine, Kikinis Col 4, lines 50-56).

With regard to claims 71, Examiner takes official notice that word processing files, audio

files, and video files, were all widely known types of files to save and transfer information at the

time of Applicant's invention. Furthermore it would have been obvious to one of ordinary skill

in the art at the time of Applicant's invention so send these types of files as attachments in order

to transfer information between users.

With regard to claims 72 and 73, Examiner takes official notice that word processing files

often could be processed (i.e. displayed) by mobile devices such as the mobile station MS of

Eggleston's system and further video files often could not be processed by mobile devices due to

their constrained resources. Thus, in view of the official notice taken in claim 71, the message

attachment could be a file type that the mobile communication device can process (e.g. word

processing file) and could also be an attachment that the mobile communication device cannot

process (e.g. video file).

With regard to claim 75, Kikinis disclosed the external device is one of a fax machine

(Col 4, lines 50-56).

With regard to claim 76, Kikinis disclosed the step of decoupling the message attachment from the e-mail message (i.e. Kikinis only sends the attachment to a fax machine which requires decouple the message attachment from the e-mail message).

With regard to claims 77 and 78, Kikinis disclosed the step of storing the e-mail message and message attachment in a message store at the host system (Col 4, lines 38-48).

The remaining dependent claims are rejected using a similar rationale as applied to the above claims.

Conclusion

3.   The prior art made of record, in PTO-892 form, and not relied upon is considered pertinent to applicant's disclosure.
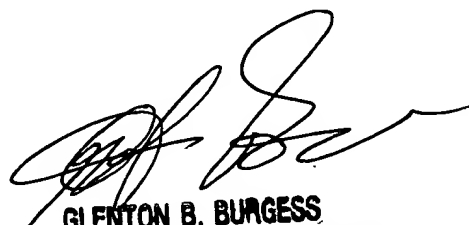
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean Reilly whose telephone number is 571-272-4228. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

March 27, 2007

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